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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,905	12/24/2003	Leon Neuer	MS-834	9169

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Bernard Malina, Esq.
Malina & Wolson
60 East 42nd Street
New York, NY 10165-0501

EXAMINER

ENGLE, PATRICIA LYNN

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,905

Applicant(s)

NEUER ET AL.

Examiner

Patricia L Engle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claims 10 and 11 are objected to because of the following informalities:

- a. In claim 10, line 2, "Fig. 6" should be --claim 6--;
- b. in claim 11, line 2, "Fig. 10" should be --claim 11--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Perlman (US Patent 1,329,627).

Regarding claim 1, Perlman discloses a retractable combination automobile sunshade and luggage carrier comprising at least one housing (3); at least one sunshade means (Y and 2) mounted in said housing (3); at least one retraction means (W) disposed supporting said housing (3) and capable of an extended and raised position (Fig. 2) and a retracted and lowered position (Fig. 1). Regarding the limitation in the preamble that the retractable device is for the a luggage carrier, that recitation has been given little patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the

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portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. The preamble limitation of the luggage carrier is not given life by the body of the claim, therefore it is viewed as an intended use. The structure of Perlman is capable of being used in on the top of a luggage carrier as well as being a sunshade.

Regarding claim 5, Perlman discloses a retractable combination automobile sunshade and luggage carrier as claimed in Claim 1 wherein said sunshade means (Y,2) comprises roller means (X,Z) mounted in said housing (3) and a flexible sunshade (Y,2) mounted on said roller means.

Regarding claim 7, Perlman discloses a retractable combination automobile sunshade and luggage carrier as claimed in Claim 1 further comprising at least one retractable door panel (3).

4. Claims 1, 3, 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Brosman (US Patent 5,280,801).

Regarding claim 1, Brosman discloses a retractable combination automobile sunshade and luggage carrier comprising at least one housing (16); at least one sunshade means (column 2, lines 48-64) mounted in said housing (16); at least one retraction means (18) disposed supporting said housing (16) and capable of an extended and raised position (Fig. 1) and a retracted and lowered position (Fig. 4). Regarding the limitation in the preamble that the retractable device is for the a luggage carrier, that recitation has been given little patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. The preamble limitation of the luggage carrier is not given life by the body of the claim, therefore it is viewed

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as an intended use. The structure of Brosman is capable of being used in on the top of a luggage carrier as well as being a sunshade.

Regarding claim 3, Brosman discloses a retractable combination automobile sunshade and luggage carrier as claimed in Claim 1 wherein said retraction means (18) comprises a linkage mechanism (column 3, line 8).

Regarding claim 4, Brosman discloses a retractable combination automobile sunshade and luggage carrier as claimed in Claim 1 further comprising actuator means (27) connected to said retraction means (28) and capable of reversibly moving said retraction means (28) from said extended position to said retracted position.

Regarding claim 7, Brosman discloses a retractable combination automobile sunshade and luggage carrier as claimed in Claim 1 further comprising at least one retractable door panel (31).

5. Claims 1-4, 6, 7, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by French (US patent 4,362,258).

Regarding claim 1, French discloses a retractable combination automobile sunshade and luggage carrier comprising at least one housing (60); at least one sunshade means (36) mounted in said housing (60); at least one retraction means (40) disposed supporting said housing (36) and capable of an extended and raised position (Fig. 2) and a retracted and lowered position (Fig. 1).

Regarding claim 2, French discloses retractable combination automobile sunshade and luggage carrier as claimed in Claim 1 further comprising seal means (25) mounted on said housing.

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Regarding claim 3, French discloses a retractable combination automobile sunshade and luggage carrier as claimed in Claim 1 wherein said retraction means (40) comprises a linkage mechanism (40).

Regarding claim 4, French discloses a retractable combination automobile sunshade and luggage carrier as claimed in Claim 1 further comprising actuator means (column 4, line 3-jack screws) connected to said retraction means (40) and capable of reversibly moving said retraction means (40) from said extended position to said retracted position.

Regarding claims 6 and 10, French discloses a retractable combination automobile sunshade and luggage carrier as claimed in Claim 1 further comprising four housings (each edge of 60) forming a rectangular array. French states that the shade is comprised of four rectangular panels (36) therefore each panel is housed on an edge of the housing (60).

Regarding claim 7, French discloses a retractable combination automobile sunshade and luggage carrier as claimed in Claim 1 further comprising at least one retractable door panel (37).

Regarding claim 11, French discloses a retractable combination automobile sunshade and luggage carrier as claimed in claim 10 further comprising a fifth sunshade means (30) mounted on a selected one of said housings (roof panel 30 is mounted on each edge (or housing) by bracket 62).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2-4, 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman.

Regarding claim 2, Perlman does not disclose that the combination includes a seal means mounted on the housing. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a seal means on the housing. The motivation would have been to prevent the housing from rattling and damaging the retractable member when it was in the lowered position.

Regarding claims 3, 4 and 8, Perlman does not disclose how the retractable member is raised and lowered. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a linkage and an actuator means to raise and lower the retractable member. The motivation would have been to allow the shade to be raised and lowered with just the touch of a button.

9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over French.

Regarding claim 8, French does not disclose a linear actuator disposed to operate said linkage. The Examiner takes Official Notice that it is well known in the art to use a linear actuator

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to operate scissor linkages to raise and lower the linkages. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a linear actuator to operate the linkages. The motivation would have been to allow the linkages to be operated mechanically and not manually.

Regarding claim 9, French discloses that only one shade panel includes a retractable door panel. It would have been obvious to one of ordinary skill in the art at the time of the invention to make all of the panel have a door panel (37). The motivation would have been to allow the maximum amount of air into the enclosure on nice days.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art discloses other sun shades and/or luggage carriers for vehicles.

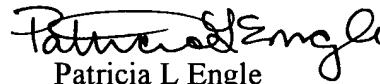
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L Engle whose telephone number is (703) 306-5777.

The examiner can normally be reached on Monday - Friday from 8:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (703) 308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L Engle
Examiner
Art Unit 3612

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May 1, 2004